

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Temple

Serial No.: 10/827,493

Group No.: 3739

Filed: April 19, 2004

Examiner: M. Kasztejna

For: HEATER FOR SURGICAL VIEWING INSTRUMENTS

**APPELLANT'S APPEAL BRIEF UNDER 37 CFR §41.37**

Mail Stop APPEAL BRIEF  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**I. Real Party in Interest**

The real party and interest in this case is John Temple, Applicant and Appellant.

**II. Related Appeals and Interferences**

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims**

The application was originally filed with 5 claims. Claim 5 was canceled by amendment. Claims 1-4 are pending, rejected and under appeal. Claim 1 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent  
To Final Rejection**

No after-final amendments have been filed.

**V. Summary of Claimed Subject Matter**

Independent claim 1 is directed to a system for warming an endoscope, laparoscope, or other such instrument to minimize fogging. The system comprises a flexible pad 160 having a length, a

width and a periphery for wrapping around the instrument. The pad includes a mixture of water and sodium acetate to generate heat through an exothermic reaction. An activation disc 152 is located around the periphery of the pad. One or more elongate partitions 164, 166 run lengthwise along the pad to establish fold lines, each partition including a gap 168, 170 to facilitate fluid transfer of the mixture. (Specification, page 4, lines 14-24)

## VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

- A. The rejection of claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,910,106 to Morgan et al.
- B. The rejection of claims 1, 2 and 4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent No. 5,651,757 to Meckstroth.
- C. The rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent No. 5,651,757 to Meckstroth, and further in view of U.S. Publication No. 2002/0022762 to Beane et al.

## VII. Argument

### A. The Rejection of Claims 1, 2 and 4 under 35 U.S.C. §102(b)

Appellant's claim 1 includes the limitations of a flexible pad for wrapping around an instrument such as an endoscope to warm the instrument. The pad includes one or more elongate partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture.

Claims 1 stands rejected under 35 U.S.C. §102(b) over Morgan et al. ('106). The Examiner's interpretation of the reference is unreasonable. The Examiner relies on Figure 2 of the '106 patent, which is reproduced below. Morgan et al. describe the figure as follows at col. 4, lines 33-51:

"FIG. 2 is a side perspective view of an instrument heater 21 according to the teachings of the present invention. The instrument heater 21 is cylindrically-shaped. The instrument heater 21 includes a sheath 23. The sheath 23 has an inner wall 25 and an outer wall 27 running across the entire length of the sheath 23. The inner wall 25 and the outer wall 27 form an essentially circular bore (not shown in FIG. 1) through the center of the sheath 23. At one end of the sheath 23 is an opening 29 which serves as the beginning of the bore. At an opposite end of the sheath 23 is a tip 31. The tip 31 is closed-ended and essentially dome-shaped.

"The inner wall 25 and the outer wall 27 are constructed of a flexible nonporous material allowing for the insulation of heat. In the disclosed embodiment, the material is chip board which is a thin cardboard type material which insulates the heat within the interior of the sheath 23. However, any flexible and nonporous material capable of being sterilized may be used."

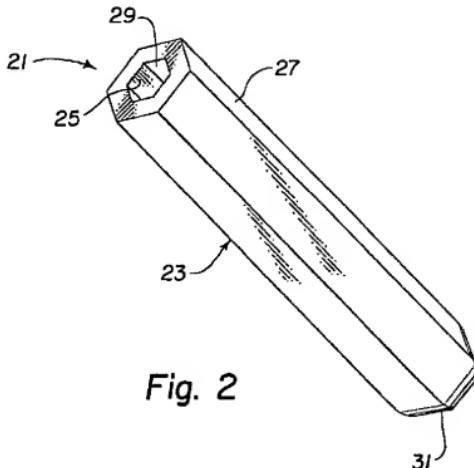


Fig. 2

It should be clear from this description that the article of Morgan has a fixed, sleeve like shape (i.e., a 'sheath'). Nevertheless, the Examiner interprets the above article as a "pad." It is also the Examiner's position that, as broadly as claimed, Morgan discloses one or more elongate partitions running along the pad to establish fold lines, and wherein each partition including a gap to facilitate fluid transfer of the mixture. As seen in Figure 2, partitions run lengthwise along the sheath and thus create a folded area. Furthermore, each partition includes a gap area which inherently facilitates fluid transfer as seen in the cross-sectional view of figure 2 [of Morgan et al.]."

These interpretations are repugnant to those understood by any person of skill in the art. The broadest reasonable interpretation must be consistent with the interpretation *that those skilled in the art would reach. In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Moreover, claim interpretation must be consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The written description must be

examined in every case, because it is relevant not only to aid in the claim construction analysis, but also to determine if the presumption of ordinary and customary meaning is rebutted. *See Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1988).

Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Systems*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." *Connell v. Sears, Roebuck Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Morgan simply does not teach or suggest "a flexible pad ... for wrapping around the instrument." Nor does Morgan teach or suggest "one or more elongated partitions running lengthwise along the pad to establish fold lines, each partition including a gap to facilitate fluid transfer of the mixture." Accordingly, *prima facie* anticipation has not been established.

#### B. The Rejection of Claims 1, 2 and 4 under 35 U.S.C. §103(a)

In the alternative, the Examiner argues that claims 1, 2 and 4 stand rejected under 35 U.S.C. §103(a) over Morgan et al., in view of Meckstroth ('757). Claims 1, 2 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent No. 5,651,757 to Meckstroth. Morgan is directed to an instrument heater for heating a surgical instrument. Morgan describes the shape and construction of the heater in detail ('106 Patent, col. 4, lines 33-51):

"The instrument heater 21 is cylindrically-shaped. ... The sheath 23 has an inner wall 25 and an outer wall 27 running across the entire length of the sheath 23. The inner wall 25 and the outer wall 27 form an essentially circular bore ... through the center of the sheath 23. At one end of the sheath 23 is an opening 29 which serves as the beginning of the bore. At an opposite end of the sheath 23 is a tip 31. The tip 31 is closed-ended and essentially dome-shaped.

"The inner wall 25 and the outer wall 27 are constructed of a flexible nonporous material allowing for the insulation of heat. In the disclosed embodiment, the material is chip board which is a thin cardboard type material which insulates the heat within the interior of the sheath 23."

Meckstroth, on the other hand, is directed to an endoscope warmer for preheating endoscopic surgical instruments. The warmer comprises a holster, a plurality of channels formed in the wall of the holster for circulating a heated fluid, a supply port and a return port for maintaining a constant supply of heated fluid, and a pocket defined by the holster for receiving at least the optical shaft portion of the instrument and, in the alternative, the entire instrument. The supply and return ports are sealingly attached to the holster and are adaptable for connection to heating units and pumps for circulating the heated fluid through the holster. ('757 Patent, Abstract)

"With reference to FIGS. 1 and 2, the pad 12 may be any pad known in the art, such as the "K-pad." The pad 12 is formed by joining two plastic, plastic-like, or similar thermal, medically safe sheets 12a and 12b along their edges 13-16 and at selected locations around its midsection. The first and second sheets 12a, 12b comprise an inner wall and outer wall which are joined by any commonly accepted practice, such as fusing, heat curing, adhesives, or other similar method." ('757 Patent, col. 5, lines 48 - 56)

The Examiner argues that it would be obvious to provide the sheath 23 of Morgan et al. with partitions, in the manner disclosed by Meckstroth, to more effectively circulate the chemical solution." This reasoning is flawed.

To establish *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this case, there is no suggestion or motivation to combine reference teachings, there is no expectation of success, and even if the combination were made, Appellant's invention would not result.

Since the sheath of Morgan is *not a pad*, it would *not be* obvious to provide the sheath with partitions "to more effectively circulate the chemical solution." The sheath 23 of Morgan does not lend itself to any "partitions" in any practical sense. There is no telling where they would go and there is no need to "establish fold lines." The preferred embodiment of Morgan includes an inner

wall 25 and an outer wall 27 constructed of "chipboard which is a thin cardboard type material which insulates the heat within the interior of the sheath 23." (See column 4, lines 45-51). Thus, since it is already in sheath form, and constructed of a material having spaced-apart walls, there is no reason or practical implementation of "partitioning." Furthermore, although the Examiner states that this would be obvious to provide "to more effectively circulate the chemical solution," the solution is not really circulated in the sense that the fluid is circulated in the '757 patent to Meckstroth. Partitions, if somehow added to Morgan, *would get in the way*.

**C. Rejection of Claim 3**

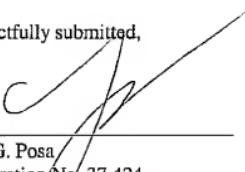
Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,910,106 to Morgan et al. in view of U.S. Patent No. 5,652,757 to Meckstroth, and further in view of U.S. Patent Application Publication No. 2002/0022762 to Beane.

The Examiner concedes that "Morgan et al. are silent as to a housing," but argues that Beane et al. demonstrate housing [sic] ... are known in the art." *But this is not the standard.* Rather, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. *In Re Dembeczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). In this case, since there is no teaching or suggestion from the prior art in support of the addition of a housing to Morgan et al., *prima facie* obviousness has not been established.

**Conclusion**

For the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

  
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APPENDIX A

CLAIMS ON APPEAL

1. A system for warming an endoscope, laparoscope, or other such instrument to minimize fogging, comprising:
  - a flexible pad having a length, a width and a periphery for wrapping around the instrument, the pad including a mixture of water and sodium acetate to generate heat through an exothermic reaction;
  - an activation disc located around the periphery of the pad; and
  - one or more elongate partitions running lengthwise along the pad to establish fold line, each partition including a gap to facilitate fluid transfer of the mixture.
2. The system of claim 1, wherein the activation disc is made of perforated stainless steel.
3. The system of claim 1, further including a housing to contain the pad in sleeve form into which the instrument is inserted.
4. The system of claim 1, further including a heat-conductive tube to receive the instrument around which the pad is wrapped.

**APPENDIX B**

**EVIDENCE**

None.

**APPENDIX C**

**RELATED PROCEEDINGS**

None.